

## **REMARKS**

In the Final Action, the Examiner relies on the primary combination of Takada (USPN 5,237,164) and Small (USPN 6,355,024) to reject all of Applicants' claims under 35 U.S.C. § 103(a). For the reasons detailed below, Applicants respectfully submit that the rejection was improper and should be withdrawn.

**I.     A Prima Facie Case of Obviousness Has Not Been Established  
Because the Asserted Prior Art Combinations Fail to Teach a Container  
with a Bar Code Where the Container Forms Part of the Code.**

Applicants submit that the combinations asserted in the Final Action to reject all of Applicants' claims fail to teach or suggest all of Applicants' claim limitations, and thus fail to establish a *prima facie* case of obviousness. See MPEP § 2143. To illustrate, the primary combination on which the examiner relies is Takada and Small.<sup>1</sup> With respect to Applicants' claim 1, this combination fails to teach the limitation of a container "wherein the container defines spaces that separate the light-reflecting segments." As recited in claim 1, the spaces define light-absorbing segments that, together with the light-reflecting segments, "define a negative image bar code representing fixed information and variable information." In other words, the combination of Takada and Small fails to teach a container having a bar code where the container itself forms part of the code.

What the combination teaches, instead, and as argued during the interview on July 5, 2004, is a bar code that is first formed and then applied to the article that will contain the code. For example, Takada teaches a card having a retroreflective bar code where the code is formed:

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<sup>1</sup> Though Takada and Small were combined with at least one other reference to reject the majority of Applicants' claims, claims 1-2, 6-7, 14-17, 22, 33, 37, 39, 43, 59 and 63-65 were rejected in view of this combination alone (Final Action at p. 2).

with black bars (or white bars) of [the] bar code printed on a prior art sheet of paper [where the retroflective material is] stuck to a base plate . . . [or alternatively where the] transparent stripes and opaque stripes are formed so as to form a bar code stuck to a sheet formed of a sheet of retroflective material.

(1:55-2:7) (emphasis added).

According to this disclosure, a bar code is first formed on paper or on a retroflective sheet, and then after being formed, the bar code is applied to a card that will contain the code.

As an additional example, the Final Action cites Figure 4 of Takada as teaching a bar code on a card substrate (Final Action at p. 2). To form the bar code of that figure, and as specifically relied upon in the Final Action (again, at p. 2), Takada discloses that:

retroreflective material 29 is stuck to a bright portion 28a on the card substrate 28. The bright portion 28a reflects light incident thereon. A dark portion 28b of the card substrate 28 is left unchanged because it is not needed to reflect incident light. The dark portion 28b can be formed by a printing process of black color having a light absorption property or the like. The retroreflective material 29 is formed by depositing a number of very small glass beads 29a on a mount 29b made of paper.

(5:39-49) (emphasis added).

Takada thus teaches that to form the bar code, the dark (light-absorbing) portion of the code must first be printed. The dark portion is then combined with the retroflective material to form the bar code. This means that the card itself does not form part of the code. Thus, the combination of Takada and Small fails to teach a container having a bar code where the container itself forms part of the code, particularly where the code represents variable information, as recited in Applicants' claim 1. For at least this reason, a *prima facie* case of obviousness has not been established.

Because each of Applicants' claims recite a similar limitation that the article of manufacture (*e.g.*, container, medical container, web, film or etc.) having the bar code forms part

of the code, and because Takada and Small is the primary combination used to reject all the pending claims, Applicants respectfully submit that a *prima facie* case of obviousness has not been established as to any pending claim. *See, e.g.*, MPEP § 2143.03 (advising that any claim that depends from a nonobvious claim is also nonobvious).

**II. Because the Motivation to Combine Takada and Small is Found Only in Applicants' Disclosure, a Prima Facie Case of Obviousness Has Not Been Established.**

Even if the combination of Takada and Small disclosed a container that forms part of a bar code (which it does not), Applicants further submit that a *prima facie* case of obviousness has not been made because only their disclosure provides the requisite motivation for the combination. This is an impermissible source, as the motivation must come from the nature of the problem to be solved, the teachings of the prior art, or the knowledge of one of ordinary skill in the art. *See* MPEP §§ 2143-2143.01.

The Examiner asserts the combination of Takada and Small is desirable because:

negative bar codes as described by Takada has to capability to read out the code from a considerably distant place, and therefore, by integrating such technology to the medical environment, medical information is update[d] by a nurse or other medical staff from a remote location without disturbing the patient or the doctor.

(Final Action at p. 3).

Applicants understand this statement to mean that the Examiner believes that the source for the motivation to combine the references is the nature of the problem to be solved, particularly updating medical information from a remote location.

Applicants agree that Takada concerns a bar code that can be read from a considerable distance, as confirmed by the following excerpts:

the present invention [provides] a card in which an object distant from several meters to several 10's of meters can be controlled [by a bar code on the card] (col. 2, lines 65-68);

it becomes possible to read out the code from a place distant from the code by several meters to several 10's of meters (col. 9, lines 15-18);

it is possible to obtain an information record medium in which the recorded information can be read out from a considerably distant place (col. 12, lines 16-19).

Takada's bar code can be detected from a considerable distance because it uses a retroreflective material,<sup>2</sup> which increases "[t]he power of the effective reflected light [by] more than 1000 times that of the power presented by the prior art bar code formed by the printed process" (col. 12, lines 6-9); *see also* (col. 6, lines 12-15). The increased detection distance was desirable to allow the bar code to be read, in particular, during "the coming and goings to [a] company building" (col. 2, lines 45-46).

Applicants' claimed invention, however, is not concerned with this problem, as bar codes on medical containers are not generally detected from a great distance because no readings or false readings may result. That is, medical containers, and flexible medical containers such as intravenous bags included within the present invention, are proximate to the patient who may be behind a privacy screen, and the container may be included in a plurality of containers in close spatial arrangement. If the medical container (containing the drug to be infused) forms part of the bar code that encodes the fixed and/or variable information about the drug and perhaps even the receiving patient, greater delivery accuracy can be achieved. This is the problem with which Applicants were concerned, which is unrelated to detection distance.

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<sup>2</sup> The bar codes are formed by selectively heating, distorting and crushing the retroreflective materials such as glass or plastic beads to create the necessary reflective difference such that the bar code may be detected (col. 10, lines 4-17; col. 11, lines 60-62).

Because neither Takada nor Small, nor their combination, teaches, suggests, or otherwise discloses a medical container that forms part of a bar code, Applicants submit that the combination of Takada and Small could have been suggested only by their disclosure. For this additional reason, Applicants respectfully submit that a *prima facie* case of obviousness has not been made with respect to any claim.

### III. CONCLUSION

The combination of Takada and Small, either alone or in combination with any other cited reference, fails to teach a container with a bar code where the container itself forms part of the code, and particularly where the code comprises variable information. Further, a *prima facie* case of obviousness has not been established because only Applicants' disclosure provides the requisite motivation to combine Takada and Small. For at least these reasons, and those detailed above, Applicants respectfully request that the rejections of the pending claims be withdrawn and the claims allowed to issue.

Respectfully submitted,

Dated: July 21, 2004

By: 

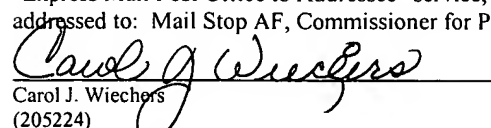
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#### CERTIFICATION UNDER 37 C.F.R. § 1.10

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